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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,617	11/21/2003	Phyllis A. Hannan	58332-8802301	3136
50379	7590	12/19/2005	EXAMINER	
SPENCER FANE BRITT & BROWNE LLP 1 NORTH BRENTWOOD BLVD. SUITE 1000 ST. LOUIS, MO 63105-3925			LEE, EDMUND H	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,617

Applicant(s)

HANNAN ET AL.

Examiner

EDMUND H. LEE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ 12/2/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's election with traverse of claims 15-17 in the reply filed on 11/29/05 is acknowledged. The traversal is on the ground(s) that claim 15 is generic to non-elected species claims 10-14. This is not found persuasive because claim 10, as worded, relates to depositing a first coloring agent in a first groove whereas claim 15, as worded, does not require deposition in a groove.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/29/05.

3. Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The relationship between steps b) and c) of claim 15 is indefinite because it is unclear whether or not the coloring agent is deposited in the groove.

Clarification is required.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budnik et al (USPN 5851335) in view of Fields et al (USPN 554335). In regard to claim 15, Budnik et al teach the basic claimed process including a method for creating a colored engraving (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7); selecting an area to be engraved on the substrate (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7); cutting a groove into the substrate at the area to be engraved, whereby an exposed substrate surface in the groove serves as a substratum on which a coloring agent is deposited (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7); depositing an amount of coloring agent on the substrate surface over the area to be engraved (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7); and heating and melting the coloring agent to cause it to fuse into the substrate surface at the are to leave a colored engraved mark in the substrate (col 3, lns 8-11; col 4, ln 47-col 5, ln 20; figs 1-7). Budnik et al, however, do not teach using a ceramic substrate. Fields et al teach a method of laser engraving ceramic substrates in order to form a colored engraved mark on a ceramic substrate (abstract; col 2, lns 23-31). It should be noted that Fields et al is being provided to merely show the obviousness of laser engraving ceramic substrates. Since Budnik et al and Fields et al are analogous with respect to laser engraving substrates, it would have been obvious to one of ordinary skill in the art at the time the invention was made to engrave a ceramic substrate as taught by Fields et al by the process of Budnik et al in order to form a colored marking fixedly secure to a ceramic substrate. In regard to claim 16, the use a specific coloring agent is a mere obvious matter of choice dependent on the desired final product and material availability and of little patentable consequence to the

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claimed process since it is not a manipulative feature or step of the claimed process. Further, colored glass frits are well-known in the molding art as an effective coloring agent. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use colored glass frits in the process of Budnik et al in order to diversify the appearance of the colored engraved markings of Budnik et al. In regard to claim 17, such is taught by Budnik et al (col 3, Ins 8-11; col 4, ln 47-col 5, ln 20; figs 1-7).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents show the state of the art: USPN 5030551; USPN 3463653; USPN 6822192; USPN 5624510; and JP 3-143570.

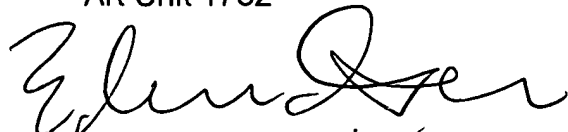
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL


12/8/05